

Application No.: 09/869,777
Response dated September 3, 2004
Reply to Office Action mailed May 3, 2004

REMARKS/ARGUMENTS

In order to further and better define the invention Claim 3 as amended includes a finite list of optional substituents. Support for the optional substituents is provided in the specification at page 4, lines 19-24 as originally filed.

In new claims 101-103, Z is selected from “-NH-(CH₂)_p-Ar-NH₂” and “-NH-(CH₂)_p-Ar-NCS”. Support for these Z groups is provided in the specification as originally filed at page 4, lines 18 to 22; Example 1 and original claim 5. Applicant submits these Z groups are free of the art. In particular, Marcuccio (WO 95/31202) does not teach or suggest cryptate ligands wherein one of the apical carbons is substituted with an aminoalkylene-(p-aminophenylene) group or an aminoalkylene-(p-thiocyanato)phenylene group (see Marcuccio, page 4 and the paragraph bridging pages 11 and 12).

In the Office Action mailed May 3, 2004, claims 35-38, 58-61, 76 and 77 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of imaging and method of radiotherapy for cancer using radionuclide complexes, was deemed to not reasonably provide enablement for generically “diagnosis” or “diagnosis of disease” or “therapy” or “therapy of a disease”. As such, the Office Action stated that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In accordance with the Examiner’s suggestions on page 4 of the Office Action, “diagnosis” and “therapy” have been separated from a single claim. Specifically, the claims have been clarified

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to claims for “A method of radioimaging” (claims 35, 62, 72, 73, 92), “A method of diagnosing” (claims 58 and 96), and “A method of radiotherapy” (claims 78, 85, 90, 91 and 97).

In the Office Action, claims 35-38, 58-61, 76 and 77 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action stated that these claims are confusing because they contain two distinct methods in a single claim, i.e., a method of “diagnosis” and “therapy” which would require different steps, particulars (dosages), etc. As noted above, in accordance with the Examiner’s suggestions on page 4 of the Office Action, “diagnosis” and “therapy” have been separated from a single claim.

In the Office Action mailed May 3, 2004, claims 35-38, 58-61, 76 and 77 were rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. In accordance with the Examiner’s suggestions on page 5 of the Office Action, these claims have been clarified to identify these claims as claims of methods for diagnosing or imaging, and to further clarify particular imaging modalities, i.e., methods of “radioimaging.”

Applicants appreciate the statement in the Office Action that claims “3, 30-34, 49-57 and 62-75 are allowed” over the prior art, and that the method claims “can be placed in condition for allowance by following the suggestions to obviate the 112 rejections set forth in the Office Action.

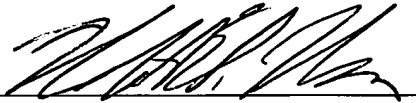
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CONCLUSION

In view of the foregoing, Applicants respectfully submit that the pending claims are in condition for allowance and request notification to that effect. The Examiner is invited to contact the undersigned should it be deemed necessary to facilitate prosecution of the application.

Respectfully submitted,

Date: September 3, 2004

By: 
Robert H. Resis
Reg. No. 32,168
Direct Dial: (312) 463-5405